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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,322	09/17/2003	Nubar Ozbalik	EI-7610	4163

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NEW MARKET SERVICES CORPORATION
(FORMERLY ETHYL CORPORATION)
330 SOUTH 4TH STREET
RICHMOND, VA 23219

EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/664,322	Applicant(s) OZBALIK ET AL.	
	Examiner Callie E. Shosho	Art Unit 1714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☒ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-3,5,6,9-14,16,17,20-24,26,27,30-34,36,37,40 and 41.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

Callie E. Shosho
 Primary Examiner
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Attachment to Advisory Action

1. Applicants' amendment filed 9/19/06 has been fully considered but the amendment has not been entered given that the amendment raises new issues that would require further consideration and search.

The amendment raises new issues under 35 USC 112, first paragraph that would require further consideration. Specifically, applicants have amended each of claim 1 and claim 12 to recite that the anti-foam agent comprises "about 0.01 to about 0.08 wt.%" of the power transmitting fluid. It is the examiner's position that this phrase fails to satisfy the written description requirement under 35 USC 112, first paragraph since there does not appear to be a written description requirement of the recited upper amount of anti-foam agent in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

As support for the above amendment, applicants point to page 14, lines 9-10 of the present specification. This portion of the specification recites the use of 0.08 wt.% anti-foam system. However, each of present claim 1 and 12 recite the use of 0.8 wt.% anti-foam agent. It is not clear what, if any, difference there is between anti-foam agent and anti-foam system or if a anti-foam system comprises ingredients other than the anti-foam agent. Further, if the anti-foam system comprises other ingredients, it is not clear what amount of the system is anti-foam agent. That is, it is not clear that 0.08 wt.% anti-foam system comprises 0.08 wt.% anti-foam agent.

Further, the amendment raises new issues that would require further search. Specifically, applicants have amended each of claim 1 and claim 12 to recite that the anti-foam agent comprises "about 0.01 to about 0.08 wt.%" of the power transmitting fluid. Given that previously

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each claim required that the anti-foam agent comprises “about 0.01 to about 1 wt. %” of the power transmitting fluid, such amendment would require new searches.

It is noted that *if* the amendment were entered, the amendment would overcome the rejection of record utilizing Dasai (U.S. 5,064,546) as set forth in paragraph 4 of the office action mailed 7/19/06.

However, it is further noted that *if* the amendment were entered, the amendment would not overcome the rejections of record set forth in paragraphs 6-10 of the office action mailed 7/19/06.

Specifically, with respect to Dasai (U.S. 5,064,546), applicants argue that there is no disclosure in Dasai of additive composition as required in present claim 22.

While it is agreed that there are no examples in Dasai of additive composition as presently claimed, it is noted that “applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others.” *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). A fair reading of the reference as a whole discloses composition comprising dioleoyl hydrogen phosphite, antioxidant, dispersant, and defoaming agent that clearly meets the requirements of present claim 22.

Applicants also argue that with respect to newly added claims 42 and 43, there is nothing in Dasai that teaches method for improving wear or anti-shudder durability of a power transmitting fluid.

However, it is noted that Dasai does teach method of formulating a power transmitting fluid comprising combining a major amount of base oil with a minor amount of friction modifier

such as dioleyl hydrogen phosphite, antioxidant, dispersant, and defoaming agent. Given that Dasai discloses method as claimed, it is the examiner's position, absent evidence to the contrary, that such method would intrinsically result in improved wear protection performance and improved anti-shudder durability performance as required in claims 42 and 43, respectively.

With respect to Tagliamonte et al. (U.S. 6,528,458), applicants argue that nothing in Tagliamonte et al. points to, or suggests, or makes obvious a choice of particular components as presently claimed to provide improved wear resistance and/or anti-shudder durability.

However, attention is drawn to example 1 of Tagliamonte et al. that discloses method as presently claimed including the use of base oil, dispersant, antioxidant, and anti-foaming agent. While there is no disclosure of specific hydrogen phosphite as presently claimed, it is the examiner's position (as set forth in the following paragraph) that it would have been obvious to use dioleyl hydrogen phosphite. Further, while it is agreed that Tagliamonte et al. disclose the use of other ingredients in addition to those explicitly claimed, in light of the open language of the present claims, i.e. "comprising", it is clear that such ingredients are not excluded from the scope of the present claims. Given that in addition to these additional ingredients Tagliamonte et al. also disclose the use of base oil as well as dialkyl hydrogen phosphite, antioxidant, dispersant, anti-foaming agent, viscosity index modifier, and friction modifier as presently claimed, it is the examiner's position that such method would intrinsically result in improved or enhanced wear protection performance and improved or enhanced anti-shudder durability performance as presently claimed. There is no evidence that the presence of the additional ingredients disclosed

by Tagliamonte et al. would effect the wear protection or anti-shudder durability of the power transmitting fluid.

Applicants also argue that Tagliamonte et al. do not disclose additive composition as required in present claim 22.

However, attention is drawn to example 1 of Tagliamonte et al. that discloses combining base oil with composition comprising dibutyl hydrogen phosphite, dispersant, antioxidant, and anti-foam agent. While there is no explicit disclosure of dioleyl hydrogen phosphite as presently claimed, col.6, lines 33-54 of Tagliamonte et al. disclose the use of fatty phosphite friction modifier of the formula $(RO)_2PHO$ wherein each R group has 8 to 24 carbon atoms and explicitly disclose that in one embodiment each R group is formed from oleyl group. Thus, it would have been obvious to one of ordinary skill in the art to use dioleyl hydrogen phosphite in example 1 of Tagliamonte et al. In light of this, it is clear that Tagliamonte et al. meet all the requirements of claim 22, i.e. composition comprising dispersant, antioxidant, anti-foam agent, and dioleyl hydrogen phosphite.

With respect to Davis (U.S. 4,231,757), applicants argue that there is no reason for one of ordinary skill in the art to select dioleyl hydrogen phosphite as the dialkyl hydrogen phosphite of Davis.

It is noted that while Davis broadly discloses the use of dialkyl hydrogen phosphite, there is no explicit disclosure of dioleyl hydrogen phosphite as presently claimed. This is why Davis is used in combination with Tagliamonte et al. that disclose the use of fatty phosphite friction modifier of the formula $(RO)_2PHO$ wherein each R group has 8 to 24 carbon atoms and

explicitly disclose that in one embodiment each R group is formed from oleyl group. It is significant to note that Tagliamonte et al. disclose that the use of dioleoyl hydrogen phosphite is preferred (col.6, lines 49-54).

Thus, given that Davis and Tagliamonte are each drawn to power transmitting fluids, given that Davis broadly disclose the use of dialkyl hydrogen phosphite, given that Tagliamonte et al. explicitly disclose the use of dioleoyl hydrogen phosphite as preferred as well as provide motivation for using such phosphite, i.e. friction modifier, it is the examiner's position that Tagliamonte et al. do provide motivation to select dioleoyl hydrogen phosphite as the dialkyl hydrogen phosphite in Davis.

Applicants also argue that there is nothing in Davis about utilizing the presently claimed combinations or utilizing them to improve wear or anti-shudder durability.

However, attention is drawn to example A of Davis, which in combination with Tagliamonte et al., discloses the presently claimed combinations. Further, given that Davis in combination with Tagliamonte et al. discloses power transmitting fluid as presently claimed including comprising additive composition as presently claimed, i.e. comprising antioxidant, anti-foaming agent, dispersant, and dioleoyl hydrogen phosphite as presently claimed, it is the examiner's position, absent evidence to the contrary, that the power transmitting fluid would intrinsically possess enhanced or improved wear protection and enhanced or improved anti-shudder durability as claimed.

With respect to Fyfe (U.S. 2004/0129603), applicants argue that there is nothing in Fyfe that points to the presently claimed combination of components nor to improvements in wear and anti-shudder achieved by the claimed combination.

However, attention is drawn to Table 3 of Fyfe that disclose adding base oil to composition comprising dispersant, antioxidant, dialkyl phosphite, and anti-foaming agent as presently claimed. While there is no disclosure of diolel hydrogen phosphite as presently claimed, this is why Fyfe is used in combination with Nelson et al. that discloses the equivalence and interchangeability of using dibutyl hydrogen phosphite, as disclosed by Fyfe, with using diolel hydrogen phosphite as claimed.

Applicants argue that there is no disclosure in Nelson et al. that dibutyl hydrogen phosphite and diolel hydrogen phosphite are equivalent and interchangeable and that Nelson et al. merely discloses long list of phosphorous components of which dibutyl hydrogen phosphite and diolel hydrogen phosphite are but two.

However, it is significant to note that Fyfe discloses the use of dibutyl hydrogen phosphite as anti-wear agent and that Nelson et al. discloses the use of anti-wear agent that includes not only dibutyl hydrogen phosphite but also diolel hydrogen phosphite. Thus, in terms of use as an anti-wear agent, it is the examiner's position that Nelson et al. do disclose the equivalence and interchangeability of dibutyl hydrogen phosphite with diolel hydrogen phosphite.

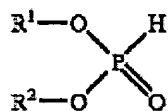
Further, given that Fyfe in combination with Nelson et al. disclose power transmitting fluid as claimed including comprising additive composition as presently claimed, i.e. comprising antioxidant, anti-foaming agent, dispersant, and diolel hydrogen phosphite as presently claimed

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and given that it is disclosed that dioleoyl hydrogen phosphite is used as an anti-wear agent, it is the examiner's position, absent evidence to the contrary, that the power transmitting fluid would intrinsically possess enhanced or improved wear protection and enhanced or improved anti-shudder durability as claimed.

With respect to Sumiejski (U.S. 2005/0014656), applicants argue that there is no motivation to use dioleoyl hydrogen phosphite as the hydrocarbyl phosphite in Sumiejski.

Sumiejski broadly disclose the use of hydrocarbyl phosphite of the formula:



wherein R¹ and R² are each hydrocarbyl groups including linear or branched alkyl group having 8 to 40 carbon atoms, however, there is no explicit disclose of the use of dioleoyl hydrogen phosphite which is why Sumiejski is used in combination with Dasai that discloses the equivalence and interchangeability of using dilauryl hydrogen phosphite, as disclosed by Sumiejski, with using dioleoyl hydrogen phosphite as claimed.

Applicants argue that there is no disclosure in Dasai that dilauryl hydrogen phosphite and dioleoyl hydrogen phosphite are equivalent and interchangeable and that Dasai merely discloses long list of phosphorous components of which dilauryl hydrogen phosphite and dioleoyl hydrogen phosphite are but two.

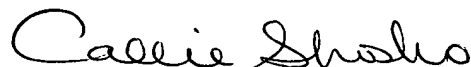
However, while dilauryl hydrogen phosphite and dioleoyl hydrogen phosphite are but two of the phosphorous components disclosed by Dasai, it is significant to note that Dasai discloses

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that all the phosphorous components function as friction modifiers. Thus, it is clear that, in terms of use as friction modifier, Dasai does disclose the equivalence and interchangeability of dibutyl hydrogen phosphite with diolel hydrogen phosphite.

Further, given that Sumiejski in combination with Dasai disclose power transmitting fluid as presently claimed including comprising additive composition as presently claimed, i.e. comprising antioxidant, foam inhibitor, dispersant, and diolel hydrogen phosphite as presently claimed, it is the examiner's position, absent evidence to the contrary, that the power transmitting fluid would intrinsically possess enhanced or improved wear protection and enhanced or improved anti-shudder durability as claimed.

In light of the above, it is the examiner's position that that *if* the amendment filed 9/19/06 were entered, the amendment would not overcome the rejections of record set forth in paragraphs 6-10 of the office action mailed 7/19/06.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
9/28/06